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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,706	09/19/2005	Kuniharu Harada	3273-0214PUS1	7685
2292	7590	08/26/2009	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			SERGENT, RABON A	
PO BOX 747				
FALLS CHURCH, VA 22040-0747			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			08/26/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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Mailed : AUG 26 2009

In re Application of

Harada et al.

Serial No. 10/549,706

Filed: September 19, 2005

For: AQUEOUS SILYLATED URETHANE COMPOSITIONS,
AQUEOUS ADGESIVES FOR WRAPPING, AND AQUEOUS
CONTACT ADHESIVES

: DECISION ON
: PETITION

This is a decision on the PETITION FILED UNDER 37 CFR 1.144 and 1.181 TO WITHDRAW THE RESTRICTION REQUIREMENT made January 4, 2009.

A review of the record indicates that the application was filed under 35 U.S.C. 371. The original claims (1-15) were drawn to a water based silylated urethane composition. A non-final office action was mailed out on June 19, 2008. Applicants responded on September 30, 2008. Claims 1-7, 9-13 and 15 were amended, claims 8 and 14 were cancelled and new claims 16-25 were added. Claims 16-25 are drawn to a method of contact adhesion using a water-based contact adhesive according to claim 15.

The Examiner issued an Office Communication on January 9, 2009. The Examiner's position was that the amendment to the claims was non-responsive per MPEP 821.03. The amended claims were not readable on the elected invention because Applicants have amended all the claims to change their scope from a composition to methods of using.

The Examiner further in the Communication established a lack of unity because of a lack of inventive step. The Examiner cited WO 93.23490. The Communication gave Applicant 30 days to respond from the mailing date. Extensions of time were available.

MPEP: 821.03 Claims for Different Invention Added After an Office Action

Claims added by amendment following action by the examiner, MPEP § 818.01, § 818.02(a), to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145.

37 CFR 1.145 Subsequent presentation of claims for different invention.

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the

claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

Applicant responded on January 29, 2009 asserting that there has been no restriction or no election in response. Applicants rely upon their Amendment filed September 30, 2008 for their response to the rejections of record. Applicants assert that claims 1-7 and 9-13 are limited to a method of wrapping of using the compositions originally claimed. Claims 15-26 are limited to a method of contact adhesion using those compositions. The inventions of current claims 1-7, 9-13 and 15-26 are therefore dominated by the scope of the invention originally covered by such claims. New composition claim 27 falls within the scope of the original claims. Applicants further assert that MPEP 817 should be followed for restriction requirement.

MPEP: 817 Outline of Letter for Restriction Requirement

The following outline should be used to set forth a requirement to restrict.

OUTLINE OF RESTRICTION REQUIRE-MENT

(A) Statement of the requirement to restrict and that it is being made under 35 U.S.C. 121

(1) Identify each group by Roman numeral.

(2) List claims in each group. Check accuracy of numbering of the claims; look for same claims in two groups; and look for omitted claims.

(3) Give short description of total extent of the subject matter claimed in each group, pointing out critical claims of different scope and identifying whether the claims are directed to a combination, subcombination, process, apparatus, or product.

(4) Classify each group.

The Examiner issued a final rejection on May 11, 2009 maintaining the restriction and withdrew claims 1-7, 9-13 and 15-16 from consideration. Claim 27 stands rejected.

DECISION

Where claims to another invention are properly added and entered in the application *before* an action is given, they are treated as original claims for purposes of restriction only. The claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application, and in any request for continued examination (RCE) which has been filed for the application. Subsequently presented claims to an invention other than that acted upon should be treated as provided in MPEP § 821.03. Election becomes fixed when the claims in an application have received an action on their merits by the Office.

If the examiner finds that a national stage application lacks unity of invention under § 1.475, the examiner may in an Office action require the applicant in the response to that action to elect the invention to which the claims shall be restricted. Such requirement may be made before any action on the merits but may be made at any time before the final action at the discretion of the examiner. Review of any such requirement is provided under §§ 1.143 and 1.144.

Applicants have not given reason as to why the lack of unity was improper. Applicant arguments are drawn towards the formality of making the restriction. It is noted that MPEP 817 while outlining how a restriction requirement *should* be made does not mandate that restriction requirement must be made that way.

A review of the record indicates that the Examiner's action is consistent with the policy set forth by MPEP 821.03 and is reasonable.

Accordingly, the petition to withdraw the restriction requirement is **DENIED**.

/Gregory L Mills/

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